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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,586	04/01/2004	Chris W. Cicenas	09086.0037-00	5862
22852	7590	01/09/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			WUJCIAK, ALFRED J	
			ART UNIT	PAPER NUMBER
			3632	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/814,586	CICENAS ET AL.	
	Examiner Alfred Joseph Wujciak III	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10/19/06.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 80 and 82-115 is/are pending in the application.
  - 4a) Of the above claim(s) 1-79 is/are withdrawn from consideration.
- 5) Claim(s) 97 is/are allowed.
- 6) Claim(s) 80-96,98-104 and 107-114 is/are rejected.
- 7) Claim(s) 105,106 and 115 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

This is the second Office action for the serial number 10/814,586, METHODS AND APPARATUSES FOR ASSEMBLING RAILINGS, filed on 4/1/04.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18 and 66-72, drawn to bracket, classified in class 248, subclass 219.1.
- II. Claims 19-30, 65 and 73-79 drawn to deck, classified in class 52, subclass 234.
- III. Claims 31-38, drawn to tool, classified in class 29, subclass 700.
- IV. Claims 39-59, drawn to method, classified in class 256, subclass 59.
- V. Claims 60-64, drawn to railing, classified in class 256, subclass 59.
- VI. Claims 80-104, drawn to railing assembly, classified in class 256, subclass 59.

Applicant's election with traverse of groups I and II in the reply filed on 2/3/06 is acknowledged. The traversal is on the ground(s) that groups I, II and VI should be examined together. This is not found persuasive because group I is direct to bracket while group II is in combination of deck and bracket. Group VI does not contain deck but has support for rail, post and bracket in combination, which is different from group I.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 82 and 111-112 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 82, line 1, "claim 82" is indefinite because it can not depend on its own claim. It should be changed to ---claim 80--- for clarification.

Claim 111, lines 1-2, "about 90 degrees" and "about 45 degrees" are vague because the examiner does not know what specific angle the applicant is defining for the first and second surfaces. The term, "about" should be deleted for clarification.

Claim 112, lines 1-4, "wherein the first configuration the longitudinal axis of the rail is at the first angle relative to a longitudinal axis of the post, and in the second configuration the longitudinal axis of the rail is at the second angle relative to the longitudinal axis of the post different from the first angle" is indefinite because the language above has been cited in independent claim 80, lines 14-19. The applicant should not repeat identical language in the dependent claim.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

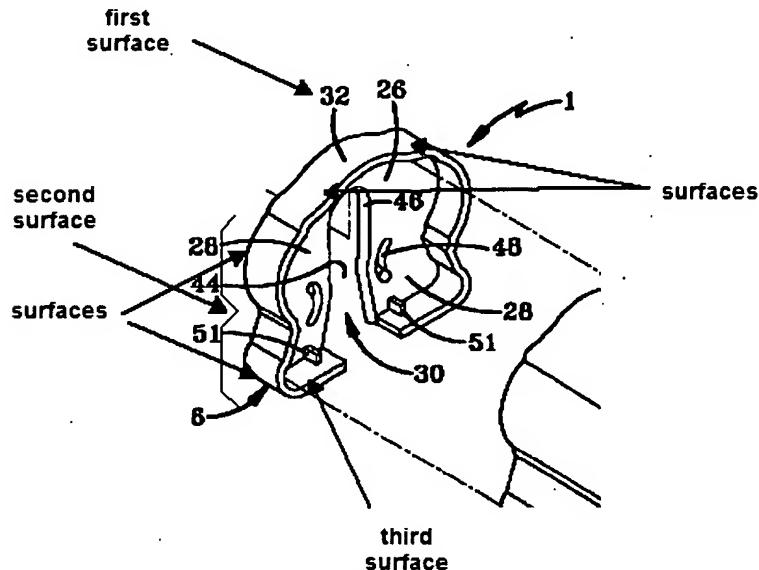
Claims 80, 82 and 84-96, 99, 104, 108-110 and 112-114 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent # 5,788,224 to Platt.

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Patt teaches a rail assembly comprising a rail (2), a post (3) and a bracket (1) for mounting the rail to the post. The bracket comprises a post surface (28) at least a portion of which is configured to abut a mounting surface of the post, at least two surfaces (32 and on the side adjacent to element 32) configured to be associated with and not parallel to the post surface of the bracket. A first surface (32) of the at least two surfaces is configured to accommodate the rail mounted to the post in a first configuration and a second surface (on the side adjacent to element 32) of the at least two surfaces is configured to accommodate the rail mounted to the post in a second configuration different from the first configuration. The first configuration of the rail is configured to be mounted to the post at a first angle relative to the mounting surface of the post and in the second configuration of the rail is configured to be mounted at a second angle relative to the mounting surface of the post different from the first angle. Both of the first configuration and the second configuration of the rail is configured to be in a substantially horizontal orientation. The first surface comprises at least two first surfaces (two surfaces are inclined from the top of element 32). The second surface comprises at least two second surfaces. The assembly further comprises the third surface (located on the bottom of the bracket) configured to be associated with the post surface. Wherein in the first configuration of the rail relative to the post, a longitudinal axis of the rail is at a first angle relative to the mounting surface of the post, and in the second configuration of the rail relative to the post, the longitudinal axis of the rail is at a second angle relative to the mounting surface of the post different from the first angle. The rail is in physical contact with both of the at least two surfaces. The rail is not in physical contact with one of the at least two surfaces (outer surface of

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1<sup>st</sup> or 2<sup>nd</sup> surface of bracket). The endmost surface of the rail is substantially parallel to the mounting surface. See drawing of figure 2 from Platt's invention shown below for clarification:



#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 98, 100-103, 107 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platt.

Platt teaches the first surface and second surface but fails to teach the first surface forms about a 45 degrees angle with the post surface and second surface forms about a 45 degrees angle with the post surface and first surface. Furthermore, Platt teaches the third surface but fails

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to teach the third surface forms about a 45 degrees angle with both the first and second surfaces.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the angle of first surface, second surface and third surface to 45 degree to provide designer's preference for improving of the railing assembly.

In regards to claim 107, Platt teaches the rail but fails to teach the rail having a substantially U-shaped cross-sectional configuration. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the shape of cross-sectional configuration to U-shaped to reduce the weight in rail.

In regards to claim 111, Platt teaches the first and second angles but fails to specify the first angle is at 90 and second angle is at 45 degrees. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the angle of first and second surfaces to 90 and 45 degrees to provide designer's preference for the appearance of the bracket.

Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Platt '224 in view of US Patent # 6,698,726 to Platt.

Platt '224 teaches the rail is configured to be mounted to the post at an angle relative to a longitudinal axis of the post but fails to teach the rail is not in the substantially horizontal orientation. Platt '726 teaches the rail (16) mounted to the post at an angle and not in the substantially horizontal orientation. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have replaced Platt '224 rail assembly with Platt'726 rail assembly to provide convenience for mounting rail at an angle that is not in horizontal orientation.

***Allowable Subject Matter***

Claims 105-106 and 115 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 97 is allowed.

In regards to claim 97, the prior art fails to teach wherein the first surface includes at least one protrusion configured to assist the first surface in receiving and retaining the first surface of another bracket. In regards to claim 105, the prior art fails to teach wherein the at least two surfaces are disposed between interior surfaces of the rail. In regards to claim 106, the prior art fails to teach wherein the rail surrounds the at least two surfaces. In regards to claim 115, the prior art fails to teach an endmost surface of the rail is in physical contact with the mounting surface.

***Response to Arguments***

Applicant's arguments filed 10/19/06 have been fully considered but they are not persuasive.

The applicant argues that Platt does not teach "wherein in the first configuration of the rail relative to the post, a longitudinal axis of the rail is at a first angle relative to the mounting surface of the post, and in the second configuration of the rail relative to the post, the longitudinal axis of the rail is at a second angle relative to the mounting surface of the post different from the first angle." The examiner disagrees with the applicant because Platt'224 shows first surface (32) extending at 90 degrees (perpendicular) in first angle to the post (3) in

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the first configuration and second surface (located at the side adjacent to element 32) extending downwardly from the first surface and side of rail at about 270 degrees, the second angle in the second configuration and that the second angle is different from the first angle.

With respect to applicant's argument regarding claim 89 that Platt fails to teach "wherein each of the at least two first surface are parallel to each other." The examiner disagrees with the applicant because the uppermost part (concave) of element 32 (first surface) is constructed of two sides thereof and the two sides are connected to the lateral sides which are the second surface. Therefore the both sides of first surface are parallel to each other.

The applicant argues that there is no reason for modifying the first surface, second surface and third surface to 45 degree because it would ruin Platt's invention. The examiner disagrees with the applicant because with modification of first, second and third surfaces to 45 degree would not ruin the invention because it will provide a press fit configuration to improve connection the rail and prevent the rail from slipping off the bracket.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Joseph Wujciak III whose telephone number is (571) 272-6827. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alfred Joseph Wujciak III  
Primary Examiner  
Art Unit 3632

1/3/07

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